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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,917	09/28/2000	Dennis R. Raffaelli	INL-00056	8566

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Warn IP Law Office
P.O. Box 70098
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EXAMINER

OJINI, EZIAMARA ANTHONY

ART UNIT PAPER NUMBER

3723

DATE MAILED: 11/05/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,917

Applicant(s)

RAFFAELLI, DENNIS R.

Examiner

Anthony Ojini

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 8,9,15,16,18,19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8,15,18, lines 1,2, the expression " wherein the abrasive grit is attached to the wheel by brazing, electroplating, sintering or resin bonding" (is unclear which element applicant is referring to.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Held (3,711,999).

With respect to claims 1-4,10 and 11, Held discloses a rotary edging wheel comprising a hub portion (see fig. 1); an outer circumferential abrading surface (16) having a width and abrasive grit attached thereto, and a circumferential groove therein (22); a radially extending planar side portion (18); a plurality of grooves (12f) extending

at an angle at least across the entire length of the abrading surface (see fig. 9) and opening into the planar surface (see fig. 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 12-14, 17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (3,711,999).

With respect to claims 5-7,12-14 and 20, Held fails to disclose optimum ranges as claimed by the applicant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with the optimum ranges as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 17, Held is discussed above in claims 1 and 10 except the optimum range as claimed by the applicant.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with the optimum range as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 8,9,15,16,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (3,711,999) in view of Hagan (5,997,597).

With respect to claims 8,15,18, Held fails to disclose the abrasive grit is attached to the wheel by brazing.

Hagan discloses an abrasive grits (26) that is grazed onto a cutting wheel (see abstract & fig. 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with an abrasive grits (26) that is grazed onto a cutting wheel in view of Hagan so as to attenuate the texture of the cutting surface of the wheel.

With respect to claims 9,16,19, Held fails to disclose the abrasive grit is a diamond hardness grit. Hagan discloses the abrasive grit is a diamond hardness grit (see col. 4, lines 10-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with an abrasive grits that is diamond hardness grit in view of Hagan so as to cut relatively hard material such as metal, concrete, stone, ceramic.

Response to Amendment

Applicant's arguments filed 6/9/03 have been fully considered but they are not persuasive. **Applicant argues** that U.S Patent No. 3,711,999 to Held "only teaches that the so-called notch (12f) is for cooling purposes, and is completely silent regarding swarf removal". However, Held discloses the concept of a rotary edging wheel for abrading comprising a plurality of grooves (12f) extending at an angle at least across the entire length of the abrading surface that is equivalent in structure with applicant's structure. It would be obvious to one having ordinary skill in the art that Held structure will inherently assist in cleaning swarfs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tone, Lehmann, Lux, Waller et al. disclose grinding wheels having a plurality of grooves extending at an angle at least across the entire length of the abrading surface. Buettner, Langlois et al. disclose cutting wheels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7.30 to 5.00 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

A handwritten signature in cursive script, appearing to read "A. Opim", is located to the right of the paragraph.

AO

October 30, 2003